

DOCKET NO: 211648US2S DIV



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
HIDEO ANDO, ET AL. : EXAMINER: FAILE, A. I.  
SERIAL NO: 09/934,827 :  
FILED: AUGUST 23, 2001 : GROUP ART UNIT: 2615  
FOR: INFORMATION RECORDING :  
MEDIUM, INFORMATION RECORDING  
METHOD AND APPARATUS, AND  
INFORMATION PLAYBACK METHOD  
AND APPARATUS

PETITION TO MAKE SPECIAL UNDER MPEP §708.02(VIII)

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

**I. Basis for the Petition**

Pursuant to MPEP §708.02(VIII) (8<sup>th</sup> ed. Rev. 2004), Applicants hereby petition for a special status for this Application.

**II. Requirements for Granting Special Status**

MPEP §708.02(VIII) established five requirements for a grant of special status. The following subsections show that each of these five requirements is satisfied in the above-identified case.

**A. Submit Petition and Fee: §708.01(VIII)(A)**

This petition is accompanied by the fee set forth in 37 C.F.R. §1.17(h).

**B. Agree to an Election Without Traverse: §708.02(VIII)(B)**

Applicants submit that Claims 37-40 as filed in the Supplemental Preliminary Amendment included herewith are directed to a single, patentable invention. If a restriction requirement is imposed in this Application, Applicants agree to elect without traverse.

**C. State that a Preexamination Search was Made: §708.02(VIII)(C)**

Applicants conducted an independent preexamination search of the PATOLIS (Patent Online Information System) to identify prior art relevant to the claimed subject matter. The search methodology entailed the use of the following keywords: play list/user-defined PGC, entry point, primary text, item text, movie AV file information, still picture video object group, time map information, VOB entry, management information, movie and still. International classes and subclasses searched include H04N5/92H and H04N5/93Z, which correspond to communication (television, art of transmission, receiving and replay of television picture). The references identified as relevant were made of record in the Information Disclosure Statements filed August 23, 2001 and July 15, 2002. The field of search included all Japanese Patent and Utility models from January 1990 to August 3, 1999 (priority date).

Further, a search was also conducted by group art unit 2615 of the Patent and Trademark Office in the parent case of the present application, namely, application 09/365,708 (now U.S. Patent 6,215,746). The search record indicates that the search of the Parent was conducted in the following U.S. classes/subclasses 369/53.2, 369/53.41, 369/47, 369/54, 369/58, 386/94, 386/95, 386/96, 386/105, 386/106, 705/52, 705/53, 705/54, and

International class G-11B 20/10. The references identified by the Patent and Trademark Office as relevant in the Parent case are also made of record in the Information Disclosure Statement filed herewith.

Together, these searches qualify as a preexamination search because the present application has not been examined on the merits and because the search methodology entailed searching by keyword and patent class in accordance with the subject matter of the disclosure.

**D. Submit a Copy of the Most Relevant References: §708.02(VIII)(D)**

Japanese Patent Application No. 8-221948 was included in the Information Disclosure Statement filed July 15, 2002 in translated form. The Information Disclosure Statement filed herewith includes a translated version of document 6-103317 and translated copies of related petitions filed in the Japanese Patent Office. Further, the Information Disclosure Statement filed herewith includes the balance of references cited by the Patent and Trademark Office in the Parent cases. All references now of record, including the references attached hereto, are discussed below with reference to the claimed subject matter of Claims 37-40.

**E. Submit a Detailed Discussion of the References, Pointing Out How the Claimed Subject Matter is Patentable Over the References: §708.02(VIII)(E)**

Consistent with the searches discussed above, Applicants respectfully submit that the claims of the Application patentably distinguish over all of the references now of record. A detailed discussion pursuant to 37 C.F.R. §1.111 is provided below for pointing out with particularity how the claimed subject matter is patentable over the references of record.

Applicants' Claim 37 recites an information recording medium comprising, *inter alia*:

a third area configured to allow allocation information to be recorded therein or reproduced therefrom;  
a fourth area provided in the third area configured to allow address information of the extent and size information of the extent to be recorded therein;  
a fifth area provided in the first area configured to allow manufacturer's information to be recorded therein;  
a sixth area provided in the fifth area configured to allow manufacturer ID information to be recorded therein; and  
a seventh area provided in the fifth area and located behind the sixth area configured to allow information set by a specific manufacturer to be recorded therein.

By way of background, optical discs employ a DVD (Digital Versatile Disc) standard for storing audio and video data as MPEG-2 encoded data structures. As the AV data is recorded onto the medium in accordance with a fixed standard, expanded functionality cannot be provided without altering the standard as the recorded data must be compatible across playback apparatuses irregardless of the manufacturer.<sup>1</sup> Thus, the claimed subject matter of the present application is provided for enabling manufacturer-specific functionality without necessitating a corresponding alteration in the standard.

Japanese Patent Application No. 6-103317<sup>2</sup> (hereafter '317') discloses that a search file (109)<sup>3</sup> is searched, image information that meets a search condition designated by a user is acquired to form a search result list, and image attribute information necessary for reading out image information is reproduced until the user selects and designates desired image information from the displayed search result list.

'317 does not disclose or suggest an information recording medium including a third area configured to allow allocation information to be recorded therein or reproduced therefrom; a fourth area provided in the third area configured to allow address information of the extent and size information of the extent to be recorded therein; a fifth area provided in the first area configured to allow manufacturer's information to be recorded therein; a sixth

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<sup>1</sup> Application at pages 1-2.

<sup>2</sup> Translated version in the IDS filed herewith.

<sup>3</sup> '317, Fig. 1.

area provided in the fifth area configured to allow manufacturer ID information to be recorded therein; and a seventh area provided in the fifth area and located behind the sixth area configured to allow information set by a specific manufacturer to be recorded therein, as recited in Applicants' Claim 37.

U.S. Patent No. 5,771,334<sup>4</sup> (Yamauchi et al., hereafter Yamauchi '334) discloses a multimedia optical disc on which a variety of types of video titles are recorded. The optical disc enables a reproduction apparatus to instantly distinguish whether emulated AV functions may be performed for any of the titles. The disc utilizes playback type information including a first flag showing whether the present video title is expressed using one or a plurality of sets of route information and a second flag showing whether a title is expressed using any branch information.<sup>5</sup>

Yamauchi '334 does not disclose or suggest an information recording medium including a third area configured to allow allocation information to be recorded therein or reproduced therefrom; a fourth area provided in the third area configured to allow address information of the extent and size information of the extent to be recorded therein; a fifth area provided in the first area configured to allow manufacturer's information to be recorded therein; a sixth area provided in the fifth area configured to allow manufacturer ID information to be recorded therein; and a seventh area provided in the fifth area and located behind the sixth area configured to allow information set by a specific manufacturer to be recorded therein, as recited in Applicants' Claim 37.

U.S. Patent No. 5,440,631<sup>6</sup> (Akiyama et al., hereinafter Akiyama) discloses an information distribution system for distributing information of a storage medium from a supplier to users through a distributor. A storage medium (1) is provided to include an

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<sup>4</sup> Cited in the IDS attached hereto.

<sup>5</sup> Yamauchi, Fig. 14.

<sup>6</sup> Cited in the IDS attached hereto.

unrewritable area (10) and a rewritable area (11). Content is provided in encrypted form in the unrewritable area of the medium. Key information stored on the medium in the rewritable area for recovering the encrypted content of the unrewritable area.<sup>7</sup> The storage medium is provided to a user from a distributor (4) after the distributor has set limits for using the information of the storage medium in accordance with input of a control center apparatus (10). In this way, upon accessing the content of the storage medium in a user apparatus (4) the access of the content can be limited in accordance with encryption permissions and usage limitations set by the distributor and/or supplier.<sup>8</sup>

Akiyama does not disclose or suggest an information recording medium including a third area configured to allow allocation information to be recorded therein or reproduced therefrom; a fourth area provided in the third area configured to allow address information of the extent and size information of the extent to be recorded therein; a fifth area provided in the first area configured to allow manufacturer's information to be recorded therein; a sixth area provided in the fifth area configured to allow manufacturer ID information to be recorded therein; and a seventh area provided in the fifth area and located behind the sixth area configured to allow information set by a specific manufacturer to be recorded therein, as recited in Applicants' Claim 37.

U.S. Patent No. 5,857,021<sup>9</sup> (Kataoka et al., hereinafter Kataoka) discloses a security system for protecting information stored in portable storage media. The system includes a security controller (12) for ascertaining the read/write permissions of a storage media utilized in terminals (11) and (10) in conjunction with an authorization table (3) of the system.<sup>10</sup> Indicia is provided on the storage medium for ensuring system security. The indicia includes medium ID, corporate ID, and a terminal ID. In order to access data of the medium, the

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<sup>7</sup> Akiyama, Figure 1; column 5, line 62 to column 6, line 4.

<sup>8</sup> Akiyama, column 6, lines 21-49.

<sup>9</sup> Cited in the IDS attached hereto.

<sup>10</sup> Kataoka, column 3, lines 11-28.

indicia is compared to data stored in the security controller for users authorized by user IDs and passwords stored in the authorization table.<sup>11</sup> In this way, the system precludes the use of non-authorized users, storage media, or the access of data from storage media via an unauthorized terminal.

Kataoka does not disclose or suggest an information recording medium including a third area configured to allow allocation information to be recorded therein or reproduced therefrom; a fourth area provided in the third area configured to allow address information of the extent and size information of the extent to be recorded therein; a fifth area provided in the first area configured to allow manufacturer's information to be recorded therein; a sixth area provided in the fifth area configured to allow manufacturer ID information to be recorded therein; and a seventh area provided in the fifth area and located behind the sixth area configured to allow information set by a specific manufacturer to be recorded therein, as recited in Applicants' Claim 37.

U.S. Patent No. 6,088,312<sup>12</sup> (Utsumi), discloses a recording apparatus for dubbing programs. The dubbing system includes a CD player (30) for providing audio content to a disc (90) on an MD recorder (1).<sup>13</sup> During a dubbing operation, the MD recorder records the digital or analog audio signal to the disc. During dubbing, it is common for a user to provide character data pertaining to the currently dubbed program. With conventional apparatuses, the input of character information must be terminated before the dubbing of the current program comes to an end. A system controller (11) is provided to determine if a program number change has occurred during dubbing, which would affect the entry of character data.<sup>14</sup> If a program number change is detected, the controller determines whether or not character input has been completed. If character input has not ended, the controller issues a

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<sup>11</sup> Kataoka, Fig. 7.

<sup>12</sup> Cited in the IDS attached hereto.

<sup>13</sup> Utsumi, Fig. 6.

<sup>14</sup> Utsumi, Fig. 7.

command to put the audio output of the disc of the CD player into a standby state. The controller also issues necessary commands to put the recording operation of the MD recorder into a standby state. The standby state remains on at the beginning of the next program, and the recording operation on the recording side is also placed in the standby state. In the meantime, the user may continue inputting the remaining characters before recording of the next program commences.<sup>15</sup>

Utsumi does not disclose or suggest an information recording medium including a third area configured to allow allocation information to be recorded therein or reproduced therefrom; a fourth area provided in the third area configured to allow address information of the extent and size information of the extent to be recorded therein; a fifth area provided in the first area configured to allow manufacturer's information to be recorded therein; a sixth area provided in the fifth area configured to allow manufacturer ID information to be recorded therein; and a seventh area provided in the fifth area and located behind the sixth area configured to allow information set by a specific manufacturer to be recorded therein, as recited in Applicants' Claim 37.

U.S. Patent No. 6,047,103<sup>16</sup> (Yamauchi et al., hereinafter Yamauchi) discloses a data transmitter for enabling copyright protection upon the retrieval of AV data. A reproduction drive (46) includes a control section for limiting the output of AV data to properly authenticated receiving devices (47).<sup>17</sup> In use, CGMS data is loaded from a storage medium, AV data is identified according to designation in the CGMS control data. Read operations of the AV data are precluded in accordance with the designations of the data in the CGMS

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<sup>15</sup> Utsumi, column 13, lines 31-47.

<sup>16</sup> Cited in the IDS attached hereto.

<sup>17</sup> Yamauchi, column 23, lines 11-27.



control data if such operations are requested by a device in which authentication has not been established.<sup>18</sup>

Yamauchi does not disclose or suggest an information recording medium including a third area configured to allow allocation information to be recorded therein or reproduced therefrom; a fourth area provided in the third area configured to allow address information of the extent and size information of the extent to be recorded therein; a fifth area provided in the first area configured to allow manufacturer's information to be recorded therein; a sixth area provided in the fifth area configured to allow manufacturer ID information to be recorded therein; and a seventh area provided in the fifth area and located behind the sixth area configured to allow information set by a specific manufacturer to be recorded therein, as recited in Applicants' Claim 37.

Japanese reference 8-221948 (hereinafter '948')<sup>19</sup>, a disk recording/reproducing apparatus is disclosed for facilitating compatibility with subsidiary information across a plurality of manufacturers and functions. '948' is directed to the utilization of a part of subsidiary information on which year, date, hour have been described. Specifically, information other than the subsidiary information is recorded in the subsidiary information recording area. The other information includes retry count or volume information, tone control information, left and right balance information, equalizer information, surround information or the like. Thus, '948' describes that, referring to information other than subsidiary information, a specific manufacturer can set functions (such as volume) of the reproducing apparatus based on the information. In this way, '948' discloses that although reproduction environments (such as volume) are different from each other, the same object can be reproduced irrespective of the specific manufacturer.

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<sup>18</sup> Yamauchi, Fig. 13.

<sup>19</sup> Translated version in the IDS filed July 15, 2002.

'948 does not disclose or suggest an information recording medium including a third area configured to allow allocation information to be recorded therein or reproduced therefrom; a fourth area provided in the third area configured to allow address information of the extent and size information of the extent to be recorded therein; a fifth area provided in the first area configured to allow manufacturer's information to be recorded therein; a sixth area provided in the fifth area configured to allow manufacturer ID information to be recorded therein; and a seventh area provided in the fifth area and located behind the sixth area configured to allow information set by a specific manufacturer to be recorded therein, as recited in Applicants' Claim 37.

As can be appreciated from the above discussion, the claimed subject matter recites the appending of manufacturer specific data on a DVD formatted disc in accordance with the data structures of the standard. In this way, manufacturers can differentiate themselves in the marketplace by virtue of unique features enabled by the specific interaction of a manufacturer with data stored in accordance with the Applicants' invention.

Claim 38 recites substantially the same limitations as Claim 37, albeit in a format for a method of reproducing. Claim 39 recites substantially the same limitations as Claim 37, albeit in a format for a method of recording. Claim 40 recites substantially the same limitations as Claim 37, albeit for an apparatus for reproducing rather than an information recording medium. Therefore, Applicants respectfully submit that the limitations defined by pending Claims 37-40 patentably distinguish over the references of record.

### **III. Conclusion**

The petition to make special meets all the requirements of MPEP §708.02(VIII), and therefore, should be granted. Accordingly, Applicants respectfully request that this Application be advanced out of turn for examination, and that the assigned Examiner,

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pursuant to the suggestions of MPEP §708.02(VIII), contact the undersigned to schedule an interview for advancing the prosecution of this case.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Customer Number

**22850**

Tel: (703) 413-3000

Fax: (703) 413 -2220  
(OSMMN 06/04)



James J. Kulbaski  
Registration No. 34,648  
Attorney of Record  
Scott A. McKeown  
Registration No. 42,866

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